

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of: Luc MOENS <i>et al.</i> | Confirmation No.: 8632 |
| Application No.: 10/544,116 | Examiner: Listvoyb, Gregory |
| Filed: October 4, 2005 | Group Art Unit: 1765 |

For: THERMOSETTING POWDER COMPOSITIONS FOR COATINGS

Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed May 20, 2011.

I. ARGUMENT

Appellants incorporate herein the arguments advanced in their Appeal Brief filed February 22, 2011. In addition, Appellants would stress the following facts and issues.

A. INDISPUTABLE FACTS

In the Appeal Brief, Appellants offered four indisputable factual findings. The Examiner's failure to refute such factual findings undermines the Examiner's obviousness conclusion.

Specifically, Appellants submitted that it was known in the art, at the time the invention was made, that isophthalic acid-rich amorphous polyesters result in powder coatings having poor flexibility and mediocre mechanical properties, citing column 19, lines 10 through 16 of the secondary reference to Moens ("Moens '721"), and paragraph 4 of the Moens Declaration.

Secondly, it was submitted that it was known that powders composed of an amorphous polyester, prepared from isophthalic acid and neopentyl glycol, have problems with respect to orange peel and lack of flexibility, again citing paragraph 4 of the Moens Declaration, and Table 2 of the '520 (present) application, Example 16. Significantly, Declarant Moens is the first listed inventor of the Examiner's secondary reference (Moens '721), downgraded from primary reference. The Examiner's reluctance to step into the ring with Declarant Moens is understandable. However, turning a blind eye to the facts upon which Declarant Moens predicated his statements is not understandable. Indeed, on page 11 of the Answer, the Examiner acknowledged the Declaration and then appears to have dismissed it, because it interprets the data in the specification. That, of course, is no excuse to ignore the facts underlying Declarant Moens's statements and conclusions.

As a third factual finding, Appellants submitted that the claimed compositions provide outstanding properties and, as a fourth factual finding, submitted that Moens '721 teaches away from the claimed invention referring specifically to Examples 31 and 32 in Table II, with corresponding data regarding mechanical properties in Table III. Again, the Examiner avoids the real issue by conveniently assuming that Appellants intended to refer to Example 2 of Moens (paragraph bridging pages 10 and 11 of the Examiner's Answer). The Examiner did not need to assume anything. All the Examiner had to do was to read Moens '721. Table II of Moens '721 makes it clear that Examples 31 and 32, upon which Appellants relied, were derived from Example 1, not Example 2. Appellants submitted that the compositions of Examples 31 and 32 were closer to the claimed invention than any prior art compositions of record, because they were entirely amorphous and, being derived from Example 1, contained isophthalic acid, neopentyl alcohol and a triol (trimethylolpropane) vis-à-vis a diol. Accordingly, the Examiner's diversion to Example 2 does not address the issue raised. The Examiner's further diversion to Kaplan

teaching a mixture of neopentylglycol with propylene glycol is also misplaced. Propylene glycol is not a linear chain aliphatic C₄-C₁₆ diol as discussed at paragraph 24 of the '520 application.

Appellants, therefore, respectfully submit that the factual findings offered in the Appeal Brief and discussed above are without dispute and sufficient to undermine the Examiner's obviousness conclusion.

B. THERE IS NO MOTIVATION

Leaving aside for a moment the indisputable facts previously discussed, and the clear evidence of record teaching away from the claimed invention, Appellants submit that one having ordinary skill in the art would not have been realistically motivated to meander through Kaplan's disclosure to arrive at the claimed invention, even absent the cross linking agent weight limitation in the ultimate two lines of claim 29. Appellants again submit that there is absolutely no guidance in Kaplan which would have led one having ordinary skill in the art to select the amorphous polyester, exclude the semicrystalline polyester, select isophthalic acid in the amount of 81 to 100% mole, and then select neopentyl glycol among the many disclosed polyols, and further add one or more linear chain aliphatic C₄-C₁₆ diol at the relative percentages specified in claim 29 for component (ii). Appellants continue to rely upon *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994) and *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992), which are believed controlling on the issue.

Significantly, the Examiner does not deny that Kaplan's disclosure encompasses "countless possible combinations" as argued by Appellants on page 6 of the Appeal Brief. Rather, the Examiner doubles down with his rubric "Kaplan's disclosure does not preclude the composition of Claim 29" (page 6 of the Answer, ultimate paragraph). There are many references that do not preclude inventions. But to say that a reference that fails to preclude a particular

composition would have rendered that composition obvious within the meaning of 35 U.S.C. §102 defies logic. Again, Appellants would rely on *In re Baird, supra* and *In re Jones, supra*.

On page 9 of the Answer, second paragraph under the caption “(10) Response to Argument”, the Examiner acknowledges Appellants’ arguments with respect to lack of motivation. As previously pointed out, Appellants’ argument, leaving aside the evidence of nonobviousness and teachings away, focused upon the countless compositions encompassed by Kaplan and the lack of motivation to arrive at the claimed invention. In apparent appreciation that Kaplan’s disclosure encompasses countless compositions, the Examiner chooses to attribute words to Appellants misdirecting attention away from the issue presented. Specifically the Examiner says “[i]n other words Appellants argue that Kaplan does not teach the following limitations of Claim 29.” The “other words” are not those of Appellants, but the Examiner’s words misdirecting attention away from the implicitly acknowledged fact that Kaplan’s disclosure encompasses countless compositions. Rather than address that fact, the Examiner excavates those components needed to arrive at the claimed invention, without any guidance from Kaplan, manifestly relying upon Appellants’ disclosure as a map.

Exacerbating the lack of any guidance in Kaplan to arrive at the claimed invention, Appellants again stress that conventional wisdom in the art taught that isophthalic acid-rich polyesters result in poor mechanical properties (Moens ‘721, column 19, lines 10 through 16; Moens Declaration, paragraph 4). Further, Moens ’721 teaches away from the claimed invention by disparaging isophthalic acid-rich amorphous polyesters, because they result in powder coatings having poor mechanical properties (Moens Declaration, paragraph 8; Moens ‘721, column 19, lines 10 through 16, Examples 31 and 32, Tables II & III). Despite such compelling evidence of record, the Examiner would swim upstream to select the components necessary to arrive at the

claimed invention. That motivation can only be found in Appellants' disclosure, which is forbidden territory. *Panduit Corp. v Dennison Mfg. Co.*, 774 F.2d 1082 (Fed. Cir. 1985).

C. UNEXPECTED RESULTS

In the Appeal Brief, Appellants relied upon unexpected results of record, notably data in the specification and in Examples 31 and 32 of Moens '721, representing compositions **closer** to the claimed invention than any composition disclosed by Kaplan. On page 12 of the Answer, second paragraph, the Examiner addressed the argued data by invoking the rubric "not commensurate in scope with the invention as claimed." The Examiner does not deny, because he cannot, that the relied upon comparison is with the closest prior art of record. The evidence clearly demonstrates that the results are unexpected and that Moens '721 teaches away from the claimed invention. Under such circumstances, the Examiner's failure to consider such evidence constitutes legal error. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed.Cir.1983) ("objective evidence of nonobviousness ... should when present always be considered as an integral part of the analysis").

II. CONCLUSION AND PRAYER FOR RELIEF

The indisputable facts of record remain indisputable. The Examiner does not deny that Kaplan's disclosure encompasses countless possible combinations. Using Appellants' disclosure as a roadmap, the Examiner plows into Kaplan, sees only what he wants to see, and ignores what he does not want to see. The Examiner also ignores indisputable evidence that conventional wisdom taught away from the claimed invention, and that the claimed invention yields unexpected results. Clearly, one having ordinary skill in the art would not have found the

claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103(a). Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection of the appealed claims.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

June 16, 2011

Date

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